

REMARKS

This communication responds to the Final Office Action dated on March 4, 2009.

No claims are amended canceled or added by this Response. Claims 1, 3-25, and 27-36 are pending in this application.

Double Patenting Rejection

Claims 1, 16, and 25 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 16, and 23, respectively, of copending Application Serial No. 10/621,227. Applicant does not admit that the claims are obvious in view of U.S. Application No. 10/621,227. However, a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(b)(iv) is enclosed herewith to obviate these rejections.

§ 102 Rejection of the Claims

Claims 25 and 27-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by Taylor et al. (U.S. Publication No. 2002/0138641; hereinafter "Taylor"). Applicant respectfully traverses the rejection and submits that a proper *prima facie* case of anticipation has not been established because Taylor does not teach each and every element recited in, or incorporated into, these claims. The identical invention must be shown in as complete detail as is contained ... in the claim.¹

Regarding claims 25-33:

Applicant cannot find any teaching in Taylor of, among things,
from a first network location, configuring a playlist of video files, ... wherein the playlist is configured at least in part by logging into the third location with a web browser,

as recited in claim 25 and incorporated into claims 27-33.

The Office Action states that it is noted that, when Microsoft® Windows Media Player is launched, the www.windowsmedia.com page is displayed and in the Windows Media Interface and wherein a user can configure a playlist by clicking on the button

¹ M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

"Library" on the menu bar.² However, the Office Action reads the proxy server 420 and database 425 of Taylor as the first location and the client 300 of Taylor as the third location.³ Thus, the reasoning of the Office Action has the play list configured from the third location (the client) when a user logs in instead of from the first location. Thus, Taylor does not teach or even suggest configuring a playlist of video files from a first network location ... in part by logging into the third location.

Additionally, Applicant cannot find in Taylor any teaching of from a first network location, configuring a playlist of video files, the video files being stored in at least one second network location ... and the playlist configured in a third location, and from the third network location, ... executing the playlist, including: pulling video content associated with two or more video files from the second network location over the network according to the playlist,

as recited in claim 25.

The Office Action reads the proxy server 420 and database 425 of Taylor as the first location, the media content server 405, 410, 415 as the second location, and the client 300 of Taylor as the third location.⁴ Taylor states that the streaming media player on client 300 (the third location) requests a media clip from proxy server 420 (the first location). Thus, in Taylor, the client plays a play list by requesting a clip from the proxy server. Taylor only states that a request can be redirected to the media content server (the second location in the reasoning of the Office Action) from the proxy server 420 (the first location).⁵

Regarding claim 34:

Applicant cannot find in Taylor any teaching of a web client to communicate with each media server through the network to configure a playlist on each media server at least in part by logging into the media server with a web browser,

as recited in claim 34 and incorporated into claims 35 and 36.

In rejecting base claim 34, note that the Office Action reads the media content servers 405, 410, and 415 of Taylor onto the video file server of the claim, and the client 300 of Taylor

² Office Action, pg. 10.

³ Office Action, pg. 10.

⁴ Office Action, pg. 10.

⁵ Taylor, ¶0036.

onto the recited plurality of media servers.⁶ Taylor states that a user (using client 300) uses a browser to connect to a media server, such as proxy server 420.⁷ Thus, in Taylor, the user and browser are at the client 300 rather than connected via a network (note the media server *is the client 300* according to the Office Action). Therefore, Taylor does not teach a web client [configuring] a playlist ... by logging into the media server through a network using a web browser, and Taylor does not teach the structure recited in the claim.

Regarding claims 25-36:

Applicant cannot find in Taylor any teaching of wherein the playlist includes at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist,

as recited in claim 25 and similarly recited in claim 34.

The Office Action states that the claimed track is interpreted as a playlist played back using WMP, wherein the playlist includes identifiers.⁸ However, the playlist in Taylor does not include a track as recited in the claims. Taylor states, in regard to FIG. 5, that play list 505 includes one or more references to media clips, such as reference 510, which may include media clip location information 515 and clip information 520.⁹ Media clip information 515 typically refers to a non-existent file or document on a proxy server, and clip information may include such things as title and author.¹⁰ The claims recite that the track includes an identifier and at least one logical action related to playing the playlist. Thus, the play list of Taylor does not include a track as recited in base claims 25 and 34.

Therefore, Taylor does not teach each and every element recited in or incorporated into these claims. Withdrawal of the rejection and allowance of claims 25 and 27-36 is respectfully requested.

⁶ Office Action, pg. 13.

⁷ Taylor, ¶0035.

⁸ Office Action, pg. 10 carryover paragraph to pg. 11.

⁹ Taylor, ¶0042.

¹⁰ Taylor, ¶0042.

§ 103 Rejection of the Claims

1. Claims 1, 7-9, 14-18, and 23-24 were rejected under 35 U.S.C. § 103(a) as being obvious over Ellis et al. (U.S. Publication No. 2005/0028208; hereinafter "Ellis") in view of Taylor.

Applicant respectfully traverses the rejection because the cited portions of Ellis and Taylor, either individually or in combination with each other or with any objective reasoning of the Office Action, do not disclose, teach, or suggest, all of the present subject matter of these claims.

For example, Applicant cannot find in the cited portions of Ellis and Taylor, among other things,

a media server configured to execute [or store] the playlist ... each playlist including ... at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist,

as recited in claim 1 and incorporated into claims 7-9 and 14-15, and similarly recited in claim 16 and incorporated into claims 17-18 and 23-24.

The Office Action concedes that Ellis does not disclose the recited playlist and track, but states that the playlist and track is disclosed in Taylor because the claimed track is interpreted as a playlist played back using WMP, wherein the playlist includes identifiers.¹¹ However, as set forth above the playlist in Taylor does not include a track as recited in the claims. Taylor states, in regard to FIG. 5, that play list 505 includes one or more references to media clips, such as reference 510, which may include media clip location information 515 and clip information 520.¹² Media clip information 515 typically refers to a non-existent file or document on a proxy server, and clip information may include such things as title and author.¹³ The claims recite that the track includes an identifier and at least one logical action related to playing the playlist. Thus, the play list of Taylor does not include the track recited in base claims 1 and 16.

Additionally, Applicant cannot find in Ellis with Taylor any disclosure teaching or suggestion of

a web client to communicate with each media server through the network to configure at least one playlist in the media server using a web browser, ... each

¹¹ Office Action, pg. 15.

¹² Taylor, ¶0042.

¹³ Taylor, ¶0042.

media server configured to execute the playlist to control video content on the video display,

as recited in claim 1.

The Office Action reads the recited media server onto the set top box 248 of user television equipment 244.¹⁴ However, Ellis relates to an interactive television program guide.¹⁵ Ellis states that the set top box 248 implements a program guide for control by user input.¹⁶ Thus, Ellis does not teach or suggest a media server to execute the playlist to control video content on the video display, but instead relates to a program guide to play a program according to user input. In Taylor, a user (using client 300) uses a browser to connect to a media server, such as proxy server 420 and to set preferences.¹⁷ Thus, in Taylor, video content is again played according to user input. Thus, the proposed combination of Ellis with Taylor does not teach or suggest all of the subject matter of claim 1.

Further, one of ordinary skill in the art would reasonably be led to combine Ellis with Taylor. Ellis refers to an interactive television program guide. A user is provided with an opportunity to adjust program guide settings,¹⁸ and provides program listings.¹⁹ The playlist in Taylor merely includes listings to one or more references to media clips.²⁰ Thus, the play list of Taylor does not add anything to Ellis.

The Office Action states that it would have been obvious to one of ordinary skill to use the play list as taught in Taylor in Ellis because this would allow Ellis to provide a user with the capability to create a list of video clips or TV programs or movies to be played back in the order specified by the user, thereby enhancing the user's interactive TV experience. However, as set forth above, Ellis already provides a listing of available programs from which the user can choose. Presumably, because the user can only choose programs that are available, the user selected play list of Taylor would not add anything to the system of Ellis, but would provide a

¹⁴ Office Action, pg. 8.

¹⁵ Ellis, Abstract.

¹⁶ Ellis, ¶¶0187, 0188.

¹⁷ Taylor, ¶0035.

¹⁸ Ellis, Abstract.

¹⁹ Ellis, ¶¶0111, 0112.

²⁰ Taylor, ¶0042.

list already provided by Ellis. Therefore, one of ordinary skill in the art at the time the present invention was made would not reasonably have been led to combine Ellis with Taylor.

In sum, because Ellis with Taylor and/or the reasoning of the Office Action fails to disclose, teach, or suggest all of the subject matter of the claims, and because one of ordinary skill would not reasonably be led to combine Ellis with Taylor, a proper *prima facie* case of obviousness has not been established. Consequently, withdrawal of the rejection and allowance of claims 1, 7-9, 14-18, and 23-24 is respectfully requested.

2. Claims 10, 19-20, and 22 were rejected under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor and further in view of Rodriguez et al. (U.S. Publication No. 2002/0007485; hereinafter "Rodriguez"). Applicant respectfully traverses the rejection because the cited portions of Ellis, Taylor, and Rodriguez, either individually or in combination with each other or with any objective reasoning provided in the Office Action, do not disclose, teach, or suggest the subject matter of these claims.

Claim 10 depends on base claim 1, and claims 19-20, and 22 depend on base claim 16. As set forth above, Ellis and Taylor fail to teach or suggest all of the elements of base claims 1 and 16 that are incorporated into the dependent claims. Rodriguez fails to teach or suggest the missing elements. For example, Applicant cannot find in the proposed combination of Ellis, Taylor, Logan and Rodriguez, among other things,

a media server configured to execute [or store] the playlist ... each playlist including ... at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist,

as similarly recited in claims 1 and 16 and incorporated into claims 10, 19-20, and 22.

Additionally, in regard to claim 10, Applicant cannot find in the cited portions of Ellis, Taylor, or Rodriguez, among other things, "wherein the logical actions include a number of times to play the files" as recited in claim 10. The Office Action concedes that this is not specifically disclosed in Ellis-Taylor, but states that this is taught in Rodriguez.²¹

²¹ Office Action, pg. 19.

However, the cited portion of Rodriguez refers to a rental period selection screen 110 and to a number of times to play the files in a playlist.²² Thus, Ellis, Taylor, Rodriguez, and/or the reasoning provided in the Office Action do not teach or suggest all of the elements of claim 10.

Therefore, Applicant respectfully requests withdrawal of the rejection and allowance of claims 10, 19-20, and 22.

3. Claims 3-6 and 11 were rejected under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor and further in view of Pendakur et al. (U.S. Publication No. 2003/0135857; hereinafter "Pendakur"). Applicant respectfully traverses the rejection because the cited portions of Ellis, Taylor, and Pendakur, either individually or in combination with each other or with any objective reasoning of the Office Action, do not disclose, teach, or suggest, the subject matter of these claims.

Claims 3-6 and 11 ultimately depend on base claim 1. As set forth above, Ellis and Taylor fail to teach or suggest all of the elements of base claim 1 that are incorporated into the dependent claims. Pendakur fails to teach or suggest the missing elements. For example, Applicant cannot find in the proposed combination of Ellis, Taylor and Pendakur, among other things,

a media server configured to execute [or store] the playlist ... each playlist including ... at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist,

as presently recited in claim 1 and incorporated into claims 3-6 and 11. Applicant respectfully requests withdrawal of the rejection and allowance of claims 3-6 and 11.

4. Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor, further in view of Pendakur and further in view of Brooks (U.S. Publication No. 2003/0056217). Applicant respectfully traverses the rejection because the cited portions of Ellis, Taylor, Pendakur and Brooks either individually or in combination with each other or with any

²² Rodriguez, ¶0051.

objective reasoning of the Office Action, do not disclose, teach, or suggest, the present subject matter of these claims.

Claims 12 and 13 ultimately depend on base claim 1. As set forth above, Ellis and Taylor fail to teach or suggest all of the elements of base claim 1 that are incorporated into the dependent claims. Pendakur and Brooks fail to teach or suggest the missing elements. For example, Applicant cannot find in the proposed combination of Ellis, Taylor, Pendakur and Brooks any teaching or suggestion of, among other things,

a media server configured to execute [or store] the playlist ... each playlist including ... at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist,

as recited in claim 1 and incorporated into claims 12 and 13. Applicant respectfully requests withdrawal of the rejection and allowance of claims 12 and 13.

5. Claim 21 was rejected under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor, further in view of Rodriguez, and further in view of Brooks. Applicant respectfully traverses the rejection because the cited portions of Ellis, Taylor, Rodriguez and Brooks, either individually or in combination with each other or with any objective reasoning of the Office Action, do not disclose, teach, or suggest, the present subject matter of these claims.

Claim 21 ultimately depends on base claim 16. As set forth above, Ellis, Taylor and Rodriguez fail to teach or suggest all of the elements of base claim 16 that are incorporated into the dependent claims. Brooks fails to teach or suggest the missing elements. For example, Applicant cannot find in the proposed combination of Ellis, Taylor, Rodriguez and Brooks, among other things,

a media server configured to execute [or store] the playlist ... each playlist including ... at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist,

as presently recited in claim 16 and incorporated into claim 21. Applicant respectfully requests withdrawal of the rejection and allowance of claim 21.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 371-2172 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date May 4, 2009

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th day of May, 2009.

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